

Remarks/Arguments

Although Applicants respectfully traverse the Restriction Requirement mailed March 10, 2003, as a courtesy Applicants have canceled all previously submitted claims and resubmitted a new set of claims. In doing so, Applicants have reduced the number of claims and simplified the organization of the claims. As a result, Applicants believe that the Restriction Requirement of March 10, 2003 is no longer applicable and Applicants request that the Restriction Requirement be reconsidered.

A. Examiner's Interview

Applicants express their appreciation to the Examiner for conducting a telephone interview with Applicants on May 8, 2003 discussing the Restriction Requirement.

B. Amended Claims

This amendment withdraws claims 1-64 and adds new claims 65-92. Specifically, claims 65 and 66 are drawn generally to methods for detecting protein-protein interaction by using fusion proteins with protein trans-splicing. Claims 67-89 define one particular species covered by claims 65 and 66, wherein at least one of the fusion proteins is anchored to the cell membrane. Among claims 67-89, claims 80-89 further limit the invention defined by claims 67-89 by adding the limitation wherein at least one of the fusion proteins is expressed in the form of an expression library. Claims 90-92 are drawn to kits whose only substantial use is to practice the methods of claims 65-89.

In view of the Restriction Requirement, Applicants have canceled claims drawn to methods for detecting modulators of protein-protein interactions using protein trans-splicing. Applicants have also removed the aspects of claims that relate to distinct species of (1) a color assay (*See Claim 4*) and (2) a cell viability assay (*See Claim 5*). Applicants believe that the subject matters of these cancelled claims are covered by the new claims 65-92.

C. Claims 67 and Claims 80-89

Applicants explain that the invention and all amended claims relate to uses of protein trans-splicing to detect protein-protein interaction. Consequently, Applicants believe that the amended claims are all related to the same mode of operation of using protein trans-splicing.

Applicants also explain that a “fusion-protein library expressed in cells” is merely a specific embodiment of claim 67 in which a plurality of prey fusion proteins are contacted with the same bait proteins. To the extent any Restriction Requirement is applied to such claims, Applicants respectfully traverse.

D. The Kit Claims and the Method Claims

The claimed kits are specifically designed for use in the method of detecting protein-protein interactions as claimed in the method claims 65-89. Indeed, each kit claims recites the limitations that “N-intein” and “C-intein” are to be used. The independent claim 90 further recites the limitation of “instructions for use in detecting protein-protein interaction.” Thus, the kits of the invention can not be used to practice another materially different process. Consequently, a restriction requirement should not be applied to the method claims and the kit claims. (See MPEP §806.05(e), 8th Edition, August, 2001, page 800-44.)

E. Serious Burden on the Examiner

In addition, Applicants respectfully submit that no serious burden would be imposed on the examiner by examining the new claims 65-92 all together even assuming that the claims are distinct. When the related inventions are shown to be distinct, the examiner must show (1) a separate classification of the subjects, (2) a separate status in the art of the subjects, or (3) a different field of search. See MPEP §808.02, 8th Edition,

August, 2001, page 800-48. Applicants respectfully submit that the claims do not have a separate status in the art and do not have a different field of search.

In order to show a separate status in the art the examiner must either (1) provide an explanation indicating a recognition of separate inventive effort by inventors, or (2) show a separate field of search. *See* MPEP §808.02(B), 8th Edition, August, 2001, page 800-48. Applicants submit that there is no recognition of separate inventive effort by inventors. Applicants also submit that there is no separate field of search because a search for protein trans-splicing would suffice for all claims of the application. Applicants note that although some claims relate to kits while other claims relate to methods, the claims are all based on the use of protein trans-splicing. Consequently, irrespective of whether the different claims would be distinctly patentable over each other, if the use of protein trans-splicing is not in prior art, the claims in the other groups would not be in prior art either. Therefore, a search for protein trans-splicing would suffice for all the amended claims. Applicants respectfully submit that the same search(es) would apply to all claims and no serious burden would be imposed on the examiner by examining the entire application. As required by MPEP §803.01, “[i]f the search and examination of the entire application can be made without serious burden, the examiner **must examine** it on the merits, even though it includes claims to independent or distinct inventions.” *See* MPEP 803, 8th Edition, August, 2001, page 800-4 (emphasis added). Therefore, any restriction requirement in this regard is respectfully traversed.

F. Conclusion

In view of the submitted amendment and the above remarks, Applicants respectfully request that the amended claims be examined together on the merits. Applicants believe that the amended claims meet the criteria of the Restriction Requirement and that the Restriction Requirement of March 10, 2003 is no longer applicable. Reconsideration of the Restriction Requirement in view of the above remarks is earnestly requested.

Respectfully submitted,



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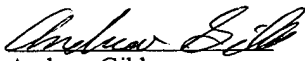
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Andrew Gibbs

5/12/03
Date